

Amdt. dated September 20, 2004

Reply to Final Office Action of April 28, 2004 and
Advisory Action of August 18, 2004

REMARKS/ARGUMENTS

Claims 1 and 11 were pending in this application. Claims 1 and 11 have been amended. No claims have been added or cancelled. Hence, claims 1 and 11 remain pending. Reconsideration of the subject application is respectfully requested.

Claims 1 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,633,545 to Milbrandt, et al. (hereinafter "Milbrandt"), and further in view of the cited portions of U.S. Patent No. 5,404,400 to Hamilton, et al. (hereinafter "Hamilton").

Claim Rejections Under 35 U.S.C. § 103(a)

The Applicants respectfully traverse the rejections of claims 1 and 11 because the office action has not established a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

(MPEP § 2143) Here, the office action has not met all three criteria. Specifically, the office action has not shown that the prior art teaches or suggests all the claim limitations and the office action does not cite a reference that teaches or suggests a motivation to combine reference teachings.

For example, with respect to claim 11 and the third prong of the test, neither of the cited references teaches "recording an entry relating to the classification in a database, wherein the entry includes the classification for the terminating connection as either an analog modem, a facsimile machine, an ISDN modem, or a voice connection" (emphasis added). Hence, claim 11 is believed to be allowable for this reason.

Moreover, with respect to the first prong of the test, the Applicants respectfully traverse the alleged motivation to combine references cited by the office action. The Applicants note that,

Appl. No. 09/686,563
Amdt. dated September 20, 2004
Reply to Final Office Action of April 28, 2004 and
Advisory Action of August 18, 2004

PATENT

[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

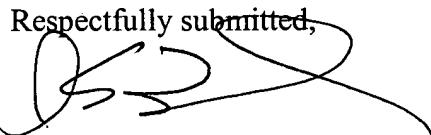
(MPEP § 2143.01) The office action states that the motivation, “to communicate with a facsimile machine,” is found in the abstract of Hamilton. This alleged motivation, however, fails to address the shortcomings in the references. Milbrandt relates to testing subscriber lines. There is no reason that someone employing the teachings of Milbrandt to test subscriber lines would desire to communicate with a facsimile machine. The motivation arises only in light of the Applicant’s teachings, and to suggest the motivation is present in the prior art amounts to impermissible hindsight. Thus, claim 11 is allowable for this additional reason.

Claim 1 includes similar limitations and is allowable for similar reasons.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

The Attorney for the Applicants hereby requests a telephone interview with the Examiner before the Examiner acts on this response. Please contact the Attorney for the Applicants at 303-607-3219 to set a mutually-agreeable date and time for the interview.

Respectfully submitted,

Irvin E. Branch
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 415-576-0300
IEB:arl
60305218 v1